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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,489	09/15/2003	Masakazu Ogawa	117147	9245

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EXAMINER

TOPGYAL, GELEK W

ART UNIT	PAPER NUMBER
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2621

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/661,489	Applicant(s) OGAWA ET AL.	
	Examiner Gelek Topgyal	Art Unit 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation function." The New IEEE Standard Dictionary of Electrical and Electronic Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held statutory).

In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

3. **Claims 9-12** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claims 9-12 define a "storage medium" embodying functional descriptive material. However, the claim does not define a computer-readable medium or memory and is thus non-statutory for that reason (i.e.,

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"When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized" – Guidelines Annex IV). That is, the scope of the presently claimed "storage medium" can range from a paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claim to embody the program on "computer-readable medium" or equivalent in order to make the claim statutory. Any amendment to the claim should be commensurate with its corresponding disclosure.

It is recommended that claims 9-12 read as follows: "A computer readable medium storing a computer program of instructions executable by a computer/processor to perform a function ..."

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 1-12** are rejected under 35 U.S.C. 102(e) as being anticipated by

Saunders et al. (US 2006/0288113).

Regarding claim 1, Saunders et al. teaches an image reproduction system that reproduces static image data synchronously with reproduction of video data, comprising:

a position information obtainment unit that obtains a reproduction time position of the video data as the video data is reproduced (Paragraph 42 teaches wherein a content author can determine the rendering time for a video component of the entire presentation. Fig. 5 further shows where Video 502 is synchronized along with other media samples/data. Paragraph 44 teaches that rendering times for each video sequences 714 are stored by the format writer 716 as part of the presentation. Paragraphs 54-57 teaches a renderer that uses a browser 758 or a multimedia player 760 that receives the presentation and reproduces according to the rendering times set in the presentation);

an image obtainment unit that obtains static image data associated in advance with the obtained reproduction time position (Paragraph 42 teaches wherein a content author can determine the rendering time for each media sample ("HTML, image") of the entire presentation. Fig. 5 further shows where media samples within Banner 504, Slides 506 are synchronized along with other media samples/data. Paragraph 44 teaches that rendering times for media samples are stored by the format writer 716 as part of the presentation. Paragraphs 54-57 teaches a renderer that uses a browser 758 or a multimedia player 760 that receives the presentation and reproduces according to the rendering times set in the presentation); and

an image reproduction unit that reproduces the obtained static image data synchronously with the video data (Fig. 5 and Paragraphs 51-53 teaches where a client access a presentation which is reproduced according to the rendering times set by the user as discussed above).

Regarding claim 2, Saunders et al. teaches an image reproduction system that reproduces static image data synchronously with reproduction of video data, comprising:

a delivery server that holds the video data and static image data associated with the video data (paragraph, 49, media server 742); and

a browsing client that reproduces and displays on a screen the video data and static image data provided by the delivery server (paragraphs 51-53, client browses a presentation),

wherein the browsing client comprises:

a position information obtainment unit that obtains a reproduction time position of the video data as the video data is reproduced (paragraphs 54-57 teaches a renderer that uses a browser 758 or a multimedia player 760 that receives the presentation and reproduces according to the rendering times set in the presentation (as discussed in claim 1 above));

an image request unit that makes a request to the delivery server for static image data associated in advance with the reproduction time position (paragraphs 51-53 teaches where a user on a client machine requests a particular presentation to be accessed/viewed. The presentation includes the still images within media samples); and

an image reproduction unit that reproduces the static image data synchronously with the video data, the static image data being provided by the delivery server in response to the request (paragraphs 56-57 teaches where a presentation, which includes video 502 and images stored by itself or within Banners 504 and/or Slides 506 are reproduced in synchronism).

Regarding claim 3, Saunders et al. teaches the claimed further comprising:

a specification unit that accepts reproduction time position information of the video data from a user's input (as discussed in claim 1 above, wherein a content author can set rendering times for video sequences 502, 714, and the plethora of media samples including still images); and

a video reproduction unit that reproduces the video data from a time position corresponding to the accepted reproduction time position information (as discussed in claim 1 above),

wherein the position information obtainment unit obtains time position information specified by the user's input (as discussed in claim 1 above, wherein a content author can set rendering times for video sequences 502, 714, and the plethora of media samples including still images).

Regarding claim 4, Saunders et al. teaches an image reproduction system that reproduces video data and plural pieces of static image data in association with each other, comprising:

a specification unit that accepts a command provided by a user's input to select one piece of static image data from the static image data pieces (paragraphs 36-37

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teaches wherein a client requests to seek to a particular point in the presentation. The client has the ability to seek to a particular point, including the locations of still images stored in banner 504 and/or slides 506); and

a video reproduction unit that reproduces the video data from a reproduction time position with which the selected piece of static image data is associated (as discussed above, after the client has chosen a particular still image, i.e. a particular location, the presentation resumes from that particular location).

Claims 5-7 and 9-11 are rejected for the same reasons as discussed in claim 2 above.

Claims 8 and 12 are rejected for the same reasons as discussed in claim 4 above.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

7. The cited references teach systems and method that allow for authoring/viewing of presentations that include audio, video, slides and other types of data.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gelek Topgyal whose telephone number is 571-272-8891. The examiner can normally be reached on 8:30am -5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

GT
8/15/2007


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